

REMARKS

Claims 3, 5-6, 9, 11, 13-14, 30-35 and 37-38 are currently under consideration in the present application. Claims 2, 4, 7, 8, 10, 12, 15, 16, 18, 21-29, 36 and 39-40 have been withdrawn from consideration by the Examiner. Claims 3, 5, 6, 9, 11, 13, 14, 17, 19, 20, 30-35, 37 and 38 stand rejected. Claims 3, 6, and 14 have been amended herein to obviate the Examiner's rejections at page 2a of the Office Action, and to and improve their form.

The Applicants note that there has been a change in the Examiner for this Application since the previous Office Action was issued and responded to.

OBJECTIONS TO THE CLAIMS

Claims 3, 6 and 14 have been amended herein to obviate the Examiner's objections as stated at page 2a of the Office Action. The amendments to claim 3 find support in paragraph [0003] of the Application, where the terms "floor covering" and "movable floor covering" are defined.

CLAIM REJECTIONS UNDER 35 USC § 103

The rejection of claims 3, 5, 6, 9, 11, 13, 14, 17, 19, 20 and 31-34, as being unpatentable over GB '993, in view of Carr (US Patent number 1,731,704) per paragraphs 6-19 of the Office Action, is traversed.

Applicants first respectfully note that claims 17, 19 and 20 have been cancelled, and therefore appear to have been erroneously included in the listing rejected claims.

Regarding all other claims under consideration, the Applicants respectfully submit that the Examiner has made several errors in the factual inquiries required under *Graham v. John Deere Co.* to support an obviousness rejection.

Independent claim 3, and claims 5, 6, 9, 11, 13-14 depending therefrom, all require, *inter alia*, a central base member including...a lower surface thereof having a lone downwardly extending threaded spike that is adapted to pass completely through the layer of pile and threadably engage the backing of the underlying floor covering for securing the apparatus to the underlying floor covering *as the central base member of the apparatus is rotated to screw the threaded spike through the backing. [Emphasis added]*.

Claims 34 and 33 similarly require that *the central base member include one or more torque receiving elements for applying torque to the apparatus, to thereby facilitate threadably screwing the apparatus into the backing of the carpet. [Emphasis added]*.

It is clear, therefore, that an apparatus according to the invention has a structure which will transmit torque applied to the central base member to the threaded spike to screw the threaded spike through the backing.

With regard to the factual analysis of the prior art, on page 3 of the Office Action, the Examiner states that "Carr teaches of a fastener including a central base member (B) and a lone downwardly extending spike...in the form of a helical thread...used to secure the fastener to the floor." The Examiner then states on page 4 of the Office Action, that "[w]ith regard to claims 33 and 34, Carr discloses grasping elements or torque receiving elements (inherent) to apply torque to the apparatus. Without such elements, the threaded portion of Carr would not be able to be threaded into the floor. Thus, gripping or torque receiving element[sic] must necessarily be present in Carr to screw the threaded portion into the floor."

The Examiner has provided no evidence that torque applied to component (B) of Carr would have the certain result of screwing the threaded portion of Carr into the floor. The Applicants submit that component (B) of Carr is most likely a plain snap having a hole in the bottom thereof through which a common screw passing through the hole in the bottom of the snap, with the screw having a head inside of the snap, and the screw head – and not component (B) – having some type of slot or other means of applying torque for screwing the threaded portion of Carr into the floor. The Examiner's assertion that component (B) of Carr must inherently include grasping elements or torque receiving elements does not, therefore, stand up to the requirements of MPEP § 2112 IV, and actually teach a non-obvious patentable difference between the combination of Carr and GB '993 under a proper factual analysis as laid out under *Graham v. John Deere Co.*

The Examiner's factual error in determining the scope and content of Carr also carries through with regard to traversal of his rejection of claim 3, and all of claims 5, 6, 9, 11, 13 and 14 depending from claim 3. It is clear, therefore, that the Carr reference cannot be relied upon to satisfy limitations of the claims of the present invention requiring that torque for screwing the threaded spike into the backing of an underlying floor covering must come for application of torque to the central base member.

It is further clear, that when properly factually analyzed, the GB '993 reference also is incapable of meeting these limitations. At page 2 of the Office Action, the Examiner erroneously states that GB '993 has "one or more downwardly extending spikes." GB '993 does not in any form include "one" downwardly extending spike. The GB '993 reference discloses and teaches only multiple downwardly extending spikes attached to a gripper plate. With multiple spikes, even if they were threaded, which is no part of the disclosure or teachings of GB '993, applying a rotational torque to the gripper plate of GB '993 would not result in the spikes being threaded into anything. The multiple spikes would prevent rotation of the plate.

The Examiner has also made other errors in the factual analysis required under *Graham v. John Deere Co.*, and consistent with the requirements of the case law as summarized in MPEP § 2112 IV. For example, at page 3 of the Office Action, the Examiner states, "GB '993 shows a downwardly extending spike that is capable of penetrating completely through the backing of an underlying substrate. The Examiner notes that "on page 2, lines 32-40 GB '993 discusses the possibility of the spikes being non-rounded, and the gripper being made of a rigid material. These characteristic would further enable the spike to penetrate through a backing." None of these assertions are supportable by intrinsic or extrinsic evidence as required under *Graham v. John Deere Co.* and MPEP § 2112 IV. They also ignore other relevant teachings of GB '993. Throughout GB '993, discussion of the construction and use of an apparatus in accordance with GB '993 make reference only to the spikes extending into the pile of a carpeting, and make no reference or inference to such spikes being capable of penetrating a backing of a carpet.

It will also be noted that at paragraph 70 of GB '993 it is stated that the spikes can be given a rounded form to ensure that the carpet pile is not damaged and that there is no risk of injury to children or pets. If the spikes are advantageously rounded so as not to damage the carpet pile, or injure children or pets, there is little likelihood that they would be sharp enough to penetrate the backing of an underlying floor covering.

In another factual error, the Applicant's respectfully note that the Examiner appears to be continually confusing a floor covering with a floor, in the manner those terms are defined and used in the present invention.

The new Examiner has also apparently erroneously fallen into the same mistaken conclusion as the previous Examiner that various limitations in the claims of the present

patent application having language such as "adapted for" or "configured" are, per se, functional rather than structural limitations. As stated in MPEP § 2111.04, where such terms state a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention. In all instances of these type of clauses in the claims of the present application, those clauses indicate structural limitations of the claim. For example, in claim 3, the first instance of the word "adapted" lays out a structure limitation regarding the size and shape of the substantially flat and planar central base so that it will lie flat between the moveable floor covering and the underlying floor covering. With regards to the spike, the use of the "adapted to" clause is a structural limitation on the length of the spike, so that it has sufficient length to meet the other limitation of the claims, and the fact that the spike must necessarily be attached to the central base member securely enough to be rotated as the central base member is rotated.

The Applicants respectfully submit that when a factually accurate comparison of the limitations of all claims under consideration of the present application is made to the combination of Carr and GB '993, it is readily apparent that the combination of those two references does not constitute a proper basis for rendering any of the claims of the present application obvious.

GB '993 does not disclose any of these limitations of claim 3, or claims 5, 6, and 9 depending from claim 3, and, therefore, cannot anticipate any of claims 3, 5, 6, or 9.

CONCLUSION

The Applicants believe that the application is in condition for allowance, and for the reasons stated above, also believe that the Examiner has not provided a proper basis for rejection of the pending claims. Reconsideration and notification of allowance are respectfully requested.

EXAMINER TELEPHONE CONFERENCE REQUESTED

If, after reviewing the above amendments and remarks, the Examiner does not believe the claims to be allowable, the Applicants request that the Examiner contact the undersigned Attorney for the Applicants, prior to issuing either an Advisory Action or another Office Action, to arrange for a telephone conference.

In re Appln. Of: Horst et al.
Application No.: 10/803,308

PROCEDURAL MATTERS AND FEES

The Applicants believe that no fees are occasioned by the submittal of this paper. If any fees are occasioned by the filing of this paper, however, the Commissioner is authorized to charge those fees, or credit any overpayments to deposit account 50-3505.

Respectfully submitted,

/Lawrence E. Crowe/

Lawrence E. Crowe, Reg. No. 35110
Reinhart Boerner Van Deuren P.C.
2215 Perrygreen Way
Rockford, Illinois 61107
(815) 633-5300 (telephone)
(815) 654-5770 (facsimile)

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